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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/523,583	03/10/2000	Youji Kawamoto	7217/61041	4985

7590 08/16/2004

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New York, NY 10036

EXAMINER
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WANG, LIANG CHE A

ART UNIT	PAPER NUMBER
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2155

DATE MAILED: 08/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/523,583

**Applicant(s)**

KAWAMOTO ET AL.

**Examiner**

Liang-che Alex Wang

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3,4,6,7,9 and 17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,6,7,9 and 17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

1. Claims 1, 3, 4, 6, 7, 9, 17 have been examined.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3, 4, 6, 7, 9, 17 are rejected under 35 U.S.C. 103(a) as being being unpatentable over Lee et al, US Patent Number 6,161,008, hereinafter Lee, In views of Floden et al., US Patent Number 6,230,002 B1, hereinafter Floden.

4. Referring to claim 1, Lee has disclosed a network system comprising:

a terminal device (see figure 1, item 120, 125, 132, 134, 140, 142);

a network server (see figure 1 item 150 and figure 4) including:

connecting means for connecting to said terminal device via prescribed

communication means (Col 2 lines 45-55), wherein a user of the network system and said terminal device to be used by the user are recorded in said network server in association with said information about terminal specification for future communication with said terminal device associated with said information about terminal specification (Col 2 lines 23-45, and Col 11 lines 12-17, 54-64, figure 4 illustrates that the user/terminal specification is stored in the network server for future communication and verification)

and said network server converts information to be transmitted to said terminal device used by the user into conformed information conformed to said terminal device used by the user, and transmits the conformed information to said terminal device (Col 11 lines 12-64); and

forming means for forming a group of a plurality of user that registered in a predetermined group (Col 11 lines 1-10, and users record in figure 4 are considered as registered users (ID 402 and password 404 indicates the user registration)) and for transmitting information sent from a user belonging to said group to a terminal device used by another user belonging to said group (user used the record saved in the PMDNS database server to reach the called party by transmitting information such as email or voice data, Col 11 lines 11-53.)

Lee has not taught wherein the terminal device include a slot for inserting and ejecting a memory device that stores information for user authentication; and wherein when said terminal device detects that said memory device is inserted into said slot, a request for authentication is sent to said network server by sending said information for user authentication and information about terminal specification to said network server.

However, Floden has taught wherein when said terminal device detects that said memory device is inserted into said slot, a request for authentication is sent to said network server by sending said information for user authentication and information about terminal specification to said network server (abstract, Col 1 lines 18-29, Col 2 lines 4-12, Col 2 line 64- Col 3 line 5, in the GSM system that authentication information is stored in the SIM card and when the device is turned on, the system would detect if the

device has a SIM card with authentication information stored-in. This action of having the device turned on seeking for authentication is viewed as a request for authentication is sent to said network server by sending said information for user authentication and information about terminal specification to said network server)

It would have been obvious to a person with ordinary skill in the art at the time the invention was made to modify the teaching of Lee such that to have terminal device including a slot for inserting and ejecting a memory device that stores information for user authentication; and wherein when said terminal device detects that said memory device is inserted into said slot, a request for authentication is sent to said network server by sending said information for user authentication and information about terminal specification to said network server.

A person with ordinary skill in the art would have been motivated to make the modification to Lee because SIM card is a well-known feature in the GSM system that provides ability for authentication information to be transferred from one device to another device. For example, if a user wishes to have her authentication information to be transferred from her old cellular phone to her new-fashioned cellular phone, all she needs to do is to place her SIM card from the old device to the new device without having to register with the service providers again. Although Lee fails to teach this improved feature of SIM card in his telecommunication system, however, Floden has taught this SIM card is defined in the Global System for Mobile Communication, therefore it would be obvious for a person with ordinary skill in the art to have Floden's GSM system to be placed on Lee's invention.

5. Referring to claim 3, Lee has further taught the network system further comprising storage means (Col 15 lines 39-42), and wherein said terminal device includes interface means connected to said storage means (Col 15 lines 39-42, Col 6 lines 64-Col 7 lines 11, and figure 2) for storing information peculiar to said user and for storing specific information on said group to which said users belongs in said storage means connected to said interface means (Col 15 lines 39-42, TID and PID are the information peculiar to the user Col 5 lines 28-32).
6. Referring to Claims 7 and 17. Claims 7, and 17 encompass the same scope of the invention as that of the Claim 1. Therefore, the Claims 7, and 17 are rejected for the same reason as the Claim 1.
7. Claims 4, 6, 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee in views of Floden in further views of Boyle et al, US Patent Number 6,138,158, hereinafter Boyle.
8. Referring to Claim 4, Lee has disclosed a network system comprising:
  - a terminal device (see figure 1, item 120, 125, 132, 134, 140, 142);
  - a network server (see figure 1 item 150 and figure 4) including:
    - connecting means for connecting to said terminal device via prescribed communication means (Col 2 lines 45-55), wherein a user of the network system and said terminal device to be used by the user are recorded in said network server in association with said information about terminal specification for future communication with said terminal device associated with said information bout terminal specification (Col 2 lines

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23-45, and Col 11 lines 12-17, 54-64, figure 4 illustrates that the user/terminal specification is stored in the network server for future communication and verification.)

forming means for forming a group of a plurality of user that registered in a predetermined group (Col 11 lines 1-10, and users record in figure 4 are considered as registered users (ID 402 and password 404 indicates the user registration)) and for transmitting information sent from a user belonging to said group to a terminal device used by another user belonging to said group (user used the record saved in the PMDNS database server to reach the called party by transmitting information such as email or voice data, Col 11 lines 11-53.)

However, Lee has not taught wherein when said terminal device detects that said memory device is inserted into said slot, a request for authentication is sent to said network server by sending said information for user authentication and information about terminal specification to said network server.

However, Floden has taught wherein when said terminal device detects that said memory device is inserted into said slot, a request for authentication is sent to said network server by sending said information for user authentication and information about terminal specification to said network server (abstract, Col 1 lines 18-29, Col 2 lines 4-12, Col 2 line 64- Col 3 line 5, in the GSM system that authentication information is stored in the SIM card and when the device is turned on, the system would detect if the device has a SIM card with authentication information stored-in. This action of having the device turned on seeking for authentication is viewed as a request for authentication is

sent to said network server by sending said information for user authentication and information about terminal specification to said network server)

It would have been obvious to a person with ordinary skill in the art at the time the invention was made to modify the teaching of Lee such that to have terminal device including wherein when said terminal device detects that said memory device is inserted into said slot, a request for authentication is sent to said network server by sending said information for user authentication and information about terminal specification to said network server.

A person with ordinary skill in the art would have been motivated to make the modification to Lee because SIM card is a well-known feature in the GSM system that provides ability for authentication information to be transferred from one device to another device. For example, if a user wishes to have her authentication information to be transferred from her old cellular phone to her new-fashioned cellular phone, all she needs to do is to place her SIM card from the old device to the new device without having to register with the service providers again. Although Lee fails to teach this improved feature of SIM card in his telecommunication system, however, Floden has taught this SIM card is defined in the Global System for Mobile Communication, therefore it would be obvious for a person with ordinary skill in the art to have Floden's GSM system to be placed on Lee's invention.

Furthermore, Lee has not explicitly taught that when there is information to be transmitted to said terminal device used by the user, said network server notifies said terminal device used by the server of the presence of the information to be transmitted.

However, Boyle has taught when there is update of a server content, the mobile would be notified with a message to make users aware that there is information for user to receive so the user can make decision if they want to receive this information or not. (Boyle, Col 5 lines 24-36.)

A person with ordinary skill in the telecommunication art would know that users could send messages to each other in the same group, and the server would first receive the message from the send user then transmit the message to the requested receiving user. Applying the teaching of Boyle allows the user be aware of the message that they are going to receive, this would allows the users to make decision if they are going to receive this information or not.

Therefore, it would have been obvious for a person with ordinary skill in the art at the time the invention was made to have the server notifies the user when there is a message going to be sent as taught by Boyle. Because having notification before actually transmitting the data would make user be aware of the information that is going to be transmitted.

9. Referring to claim 6, Lee has further taught the network system further comprising storage means (Col 15 lines 39-42), and wherein said terminal device includes interface means connected to said storage means (Col 15 lines 39-42, Col 6 lines 64-Col 7 lines 11, and figure 2) for storing information peculiar to said user and for storing specific information on said group to which said users belongs in said storage means connected to said interface means (Col 15 lines 39-42, TID and PID are the information peculiar to the user Col 5 lines 28-32).

10. Referring to Claim 9. Claim 9 encompasses the same scope of the invention as that of the Claim 4. Therefore, the Claim 9 is rejected for the same reason as the Claim 4.

***Response to Arguments***

11. Applicant's arguments filed 07/16/04, have been fully considered but they are not persuasive.
12. In that remarks, applicant's argues in substance:

That: the combination of Lee and Floden fails to show or suggest "forming a group of a plurality of user that registered in a predetermined group."

This is not found persuasive because as indicated in the remark (page 2), Lee teaches dividing a large database server (210 in Fig.3) into a plurality of more manageable smaller databases (302-308 in Fig. 3). These smaller databases may be formed by grouping users in alphabetical order (e.g. A-F, G-S, T-Z) or beginning with specific numbers (e.g. 1-2, 3-6, 7-0). See col. 10, line 66 to col. 11, line 11 of Lee et al. The action of grouping users into each smaller database is viewed as "forming a group of a plurality of user (smaller databases are formed by grouping user) that registered (according to *Merriam-Webster Online Dictionary*, "register" means "to make a record of" and "to make or adjust so as to correspond exactly") in a predetermined group (alphabetical order or specific number are predetermined group)."

***Conclusion***

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Liang-che Alex Wang whose telephone number is (703) 305-8159. The examiner can normally be reached on Monday thru Friday, 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain T Alam can be reached on (703)308-6662. The fax phone numbers for the organization where this application or proceeding is assigned is (703) 872-9306 for regular communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status

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information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Liang-che Alex Wang  
August 9, 2004

  
HOSAIN ALAM  
SUPERVISORY PATENT EXAMINER